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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/731,211	12/06/2000	Joseph Thomas O'Neil	2000-0356	8625
26652	7590	05/20/2004	EXAMINER	
AT&T CORP. P.O. BOX 4110 MIDDLETOWN, NJ 07748			LY, NGHI H	
			ART UNIT	PAPER NUMBER
			2686	9

DATE MAILED: 05/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/731,211

Applicant(s)

O'NEIL, JOSEPH THOMAS

Examiner

Nghi H. Ly

Art Unit

2686

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5 and 9-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5 and 9-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings were received on 02/23/2004. These drawings are acceptable.

Claim Rejections - 35 USC § 112

2. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding claim 1, a newly added limitation recites “comparing the demographics information of the user wireless terminal to products and/or services offered by the seller and, if the demographics information is consistent with the seller”.

However, in the Applicant's specification page 12, lines 4-5 of the present invention, it merely discloses “*comparing merchant location information from merchant database 250 with user location samples from measurements log 260*” (also see Applicant's specification page 18, lines 3-4).

Therefore, the above claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3, 5, 9-13 and 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stewart (US 6,546,257) in view of Calvert (US 6,526,275).

Regarding claims 1 and 10, Stewart teaches a method of selecting merchants for transmission of advertising information (see column 2, lines 63-67) to a user of a mobile wireless terminal (see fig.1 wireless connection between portable telephone 28 and base station 17), comprising: comparing a plurality of geographic location samples of a wireless terminal with a geographic location of a seller to determine whether the wireless terminal has frequently traveled in proximity to the seller (see column 7, lines 18-27), and if the wireless terminal has frequently traveled in proximity to the seller (see column 5, lines 44-52), selecting the seller as an entity that may be interested in having an advertisement transmitted to a user of the terminal (see column 11, lines 5-21).

Stewart does not specifically disclose comparing the demographics information of the user wireless terminal to products and/or services offered by the seller and, if the demographics information is consistent with the seller.

Calvert teaches comparing the demographics information of the user wireless terminal to products and/or services offered by the seller and if the demographics information is consistent with the seller (see column 3, lines 29-38, column 9, lines 16-21, see column 14, lines 5-29, and see column 15, lines 45-59).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Calvert into the system of Stewart in order to determine the likelihood that the device user will actually purchase or otherwise obtain their product and, therefore, whether or not to expect a financial return or other benefit from the costs of advertising their products to the device user (see Calvert, column 9, lines 28-34).

Regarding claims 2 and 11, Stewart further teaches determining whether the wireless terminal has frequently traveled in proximity to the seller involves determining whether a predetermined number of the geographic location samples are within a predetermined distance of the seller (see column 2, lines 14-19 and see column 2, lines 58-63).

Regarding claim 3, Stewart further teaches selecting the seller is dependent upon timing information associated with the wireless terminal's travels in proximity to the seller (see column 11, lines 29-53).

Regarding claim 5, Stewart further teaches selecting the seller is dependent upon whether the seller is of the type seller from whom the user is willing to accept advertisements (see column 11, lines 1-28).

Regarding claim 9, Stewart further teaches the plurality of geographic samples of a wireless terminal are represented by latitude and longitude coordinates (see column 7, lines 18-21 and column 7, lines 62-63 "GPS").

Regarding claim 15, Stewart further teaches the advertisement is transmitted using a medium from the group consisting of e-mail, voice mail, facsimile, paper, banner ads and television commercials (see column 12, lines 39-43).

Regarding claim 16, Stewart further teaches the advertisement is transmitted to the user of the wireless terminal in accordance a user delivery preference (see column 10, lines 39-43).

Regarding claim 17, Stewart further teaches the making an offer to the seller to advertise to the user of the wireless terminal (see column 2, lines 63-67 or see column 1, lines 42-63).

Regarding claim 18, Stewart further teaches purging location samples after a predetermined period of time (see column 3, lines 1-4).

Regarding claims 12 and 13, Stewart teaches the method of claims 10. Stewart does not specifically disclose receiving an indication of the seller's willingness to pay for transmission of the advertisement to the user of the wireless terminal.

Calvert teaches receiving an indication of the seller's willingness to pay for transmission of the advertisement to the user of the wireless terminal (see column 3, lines 34-39 or see column 19, lines 30-36)

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Calvert into the system of

Stewart in order to allow the user of wireless terminal to know he/she does not have to pay for the advertising fees.

5. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stewart (US 6,546,257) in view of Calvert (US 6,526,275)v and further in view of Chern et al (US 6,456,854).

Regarding claim 14, the combination of Stewart and Calvert teaches the method of claims 10. The combination of Stewart and Calvert does not specifically disclose that the location samples of the wireless terminal are received via a web interface.

Chern teaches the location samples of the wireless terminal are received via a web interface (see column 8, lines 21-25).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Chern into the system of Stewart and Calvert so that the location of a mobile telephone device can be obtained through the internet (see Chern, column 1, lines 60-65).

Response to Arguments

6. Applicant's arguments filed 02/23/2004 have been fully considered but they are not persuasive.

On page 6 of applicant's remarks, applicant argues that "there is no teaching or suggestion in Calvert, either alone or in combination with Stewart, regarding the use of demographic information as part of the seller selection process."

The examiner, however, disagree, in Calvert, (see column 3, lines 29-38) teaches "*demographics information pertaining the user of the communication device, to a plurality of product provider*", (column 9, lines 16-21) teaches "*general demographic information of the device user to the selected product providers*" and also (see column 14, lines 5-29, and see column 15, lines 45-59) which teaches applicant's claimed limitation. Therefore, the combination of Calvert and Stewart does indeed teach applicant's claimed invention.

On page 6 of applicant's remarks, applicant further argues that "Chern lacks any teaching of using demographic information of the potential purchaser in the merchant selection process."

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, Calvert teaches using demographic information of the potential purchaser in the merchant selection process, and the combination of Stewart, Calvert and Chern does indeed teach applicant's claimed invention. In addition, applicant's attention is directed to the rejection of claim 10 above.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nghi H. Ly whose telephone number is (703) 605-5164. The examiner can normally be reached on 8:30 am-5:30 pm Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on (703) 305-4379. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nghi H. Ly

KOL
05/15/04


CHARLES APPIAH
PRIMARY EXAMINER